REMARKS/ARGUMENTS

Claims 1-26 are pending in this application. Claims 1 and 15 are independent claims. Claims 1, 14-15 and 21 have been currently amended.

Specification

The amendment filed April 2, 2004 was "objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure" (Office Action, page 32). Applicant has deleted "to be transferred" from Claims 1 and 15 in accordance with the Patent Office's instruction.

Claim Rejections – 35 USC § 103(a)

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige et al. ("Nagashige", U.S. Patent Number 5,313,588) in view of Wilson et al. ("Wilson", U.S. Patent Number 6,738,821). Claims 2-3 and 5-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige and Wilson in view of Richardson ("Richardson", U.S. Patent Number 6,205,506). Claims 4 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige, Wilson and Richardson and further in view of Su et al. ("Su", U.S. Patent Number 6,047,339). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige and Wilson in view of Morris et al. ("Morris", U.S. Patent Number 6,434,650). Claims 10-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige, Wilson and Morris in view of Daniel et al. ("Daniel", U.S. Patent Number 5,726,985). Claims 12-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige, Wilson and Morris in view of Su. Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige, Wilson and Morris in view of Blumenau ("Blumenau", U.S. Patent Number 6,263,445). Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige, Wilson in view of Su. Claims 16-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige, Wilson and Su in view of Richardson. Claims 20 and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige, Wilson and Su in view of Kang ("Kang", U.S. Patent Number 6,052,133). Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagashige, Wilson Su, and Kang in view of Blumenau. Claims 25-26 were rejected under 35 U.S.C. §

103(a) as being unpatentable over Nagashige, Wilson, Su and Kang in view of Daniel. Applicant respectfully traverses these rejections.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Independent Claim 1 recites elements of "a computer system having a processor for forming a plurality of bus operation information structures, ... said each bus operation information structure including both a command and data" and "the computer system includes a central processing unit (CPU) and a bus adapter, the bus adapter including the processor, the sequencer and the memory spaces, the CPU being communicatively coupled to the bus adapter" (emphasis added). Applicant respectfully submits that the foregoing-indicated elements were not taught, disclosed, or suggested by any of the references indicated by the Patent Office (i.e., Nagashige, Wilson, Su, Morris, Daniel, Blumenau and Kang) or any combination of the references.

The Patent Office has relied on FIG. 4 and col. 8, lines 20-23 of Nagashige for teaching "a processor for forming a plurality of bus operation information structures" recited in Claim 1 (Office Action, page 2). However, col. 8, lines 20-23 of Nagashige teaches "[a] command 1 is written to the first-stage command FIFO memory 413 by the CPU. The next command 2 from the CPU is written to the second-stage command FIFO memory 414" (emphasis added). In other words, Nagashige teaches a CPU for forming commands, which is *not* "a processor for forming a plurality of bus operation information structures" recited in Claim 1 since "the processor" is not "the CPU" according to Claim 1 (because Claim 1 recites "the bus adapter including the processor, the sequencer and the memory spaces, the CPU being communicatively coupled to the bus adapter").

In addition, the Patent Office admits that "Nagashige, Wilson, and Morris do

not teach the computer system including a CPU and a bus adapter; the bus adapter including the processor" (Office Action, page 17, lines 4-5). The Patent Office relied on FIG. 3 and col. 6, lines 46-51 of Blumenau for teaching "a bus adapter that includes a processor" (Office Action, page 17, lines 9-10). However, Blumenau teaches "[t]he processor 41 controls the flow and format of data into and out of the HBA 45" (emphasis added) (col. 6, lines 46-48), *not* "a processor for forming a plurality of bus operation information structures, ... said each bus operation information structure including both a command and data" recited in Claim 1.

At least based on the foregoing described reasons, the rejection of Claim 1 should be withdrawn, and Claim 1 should be allowed.

Claims 2-14 depend from Claim 1 and are therefore nonobvious due to their dependence. Thus, the rejection should be withdrawn, and Claims 2-14 should be allowed.

For the similar rationale as applied to Claim 1, the rejection of independent Claim 15 should be withdrawn, and Claim 15 should be allowed.

Claims 16-26 depend from Claim 15 and are therefore nonobvious due to their dependence. Thus, the rejection should be withdrawn, and Claims 16-26 should be allowed.

Furthermore, it is respectfully submitted that a *prima facie* case of obviousness for the present invention has not been established by the Patent Office due to a lack of suggestion or motivation to combine the references.

As the Patent Office is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.,* 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Patent Office may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

> The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. .... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed

> invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (emphasis added) *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

In rejecting the present invention, the Patent Office has selected portions from *seven* references (i.e., Nagashige, Wilson, Su, Morris, Daniel, Blumenau and Kang) to arrive at the present invention, in which, none of the references supply the motivation for the additional reference as proposed. Rather, the references are relied upon for selected elements (e.g., Nagashige for "the bus adapter includes the sequencer and the memory spaces" – Office Action, page 17, lines 2-3; Wilson for "an encapsulated command, which is equivalent to a bus operation information structure" – Office Action, page 3, lines 12-13"; Blumenau for "a bus adapter that includes a processor and memory" – Office Action, page 17, lines 9-10; etc.), but the desirability of the elements in the combination has not been supplied *absent* the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness for the present invention has not been established.

CONCLUSION

In light of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in the case.

Respectfully submitted on behalf of
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Dated: August 4, 2004

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